IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chen et al.**	§	Group Art Unit: **3715**
	§	
Serial No. **10/631,068**	§	Examiner: **Utama, Robert J.**
	§	
Filed: **July 31, 2003**	§	Confirmation No.: **3486**
	§	
For: **Chinese/English Vocabulary**	§	Attorney Docket No.: **AUS920030521US1**
Learning Tool	§	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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REPLY BRIEF (37 C.F.R. 41.41)

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This Reply Brief is submitted in response to the Examiner's Answer mailed on July 9, 2009.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457.

RESPONSE TO EXAMINER'S ANSWER

I.   GROUND OF REJECTION 1 (Claims 1, 4, 14, and 17 – Group A)

Claims 1, 4, 14, and 17 stand rejected under 35 U.S.C. § 103(a) over Stansvik, in view of Edberg, in view of Kobayashi, and further in view of Loebner. Office Action dated January 26, 2009 pp. 2-4. This rejection is respectfully traversed.

Claim 1 is representative of group A (claims 1, 4, 14, and 17) with respect to the ground of rejection 1, and the same arguments made for Claim 1 apply to claims 4, 14, and 17.

A.   The Proposed Combination Fails to Teach or Suggest "responsive to a user selecting . . . a question language from English, Simplified Chinese, Traditional Chinese, or Pin Yin, and an answer language from English, Simplified Chinese, Traditional Chinese, or Pin Yin, displaying . . ."

With respect to Appellants' argument on the rejection under 35 U.S.C 103(a) on claims 1, 4, 14, and 17 as rejected over Stansvik, Edberg, Kobayashi and Loebner, the arguments presented by the Examiner further demonstrate that the Examiner erred in rejecting claims 1, 4, 14, and 17 over the combination of Stansvik, Edberg, Kobayashi, and Loeb.

The Examiner's first responsive argument is that the "Stansvik reference already provides a teaching where the user can select a question and answer language (see Stansvik paragraph 48-49 and FIG 5B)". The Examiner errs because he ignores all words in the claim limitation. Specifically, the Examiner merely looks for a question language and an answer language, while ignoring "from English, Simplified Chinese, Traditional Chinese, or Pin Yin, and an answer language from English, Simplified Chinese, Traditional Chinese, or Pin Yin." The claim is illustrated in Appellants' Figure 6. Appellants' Figure 6 shows a graphical user interface providing the ability for a user to select one of four choices for a question language and one of four choices for an answer language. Therefore, there are sixteen (16) combinations of question language and answer language. Stansvik is silent as to this function, and, furthermore, is incapable of performing this function, even assuming *arguendo* that a proper reference could be combined with Stansvik to achieve the function.

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Welcome to the Chinese - English Vocabulary
Learning Tool Main Menu

    Step 1
       Please choose a chapter:

             Chapter 1: Colors              ▲
    402      Chapter 2: Foods
             Chapter 3: Days, Months, & Seasons
             Chapter 4: Daily Activities      ▼

    Step 2
       Please choose a question language:
             O Traditional Chinese
             O Simplified Chinese
    404
             O Pin Yin
             ⊙ English

    Step 3
       Please choose an answer language:
             O Traditional Chinese
             ⊙ Simplified Chinese
    406
             O Pin Yin
             O English

    Step 4
    408    [ Review Vocabulary ]    [   Exit   ]    410
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FIG. 6

As illustrated above and also as illustrated in Figure 6, Appellants claim 1 provides sixteen different combinations of question languages and answer languages. Even the English and English combination has value since reading the chapter there may comprehension questions in which such a combination could be used. The combinations are shown for illustration in Table 1 below:

Question	Answer
Traditional Chinese	Traditional Chinese
Traditional Chinese	Simplified Chinese
Traditional Chinese	Pin Yin
Traditional Chinese	English

Simplified Chinese	Traditional Chinese
Simplified Chinese	Simplified Chinese
Simplified Chinese	Pin Yin
Simplified Chinese	English
Pin Yin	Traditional Chinese
Pin Yin	Simplified Chinese
Pin Yin	Pin Yin
Pin Yin	English
English	Traditional Chinese
English	Simplified Chinese
English	Pin Yin
English	English

Table 1

Table 1 was not included in the application, but Appellants submit that the derivation of the combinations can be made from the claim language alone.

As will be shown below, the Examiner ignores this function of claim1. Specifically, the Examiner states:

> The appellant argues that the limitation requires a user to select an answer language and a question language and that the combination of references failed to show teaching for this limitation. The examiner respectfully disagrees. The examiner would like point out that the Stansvik reference already provides a teaching where the user can select a question and answer language (see Stansvik paragraph 48-49 and FIG 5B). In this particular case, the figures and citation of the Stansvik reference shows where the user can select computer to display a question language in English and the answer language in Spanish (see Stansvik FIG 5B, 82, 86, 90 "The House" as question language and FIG 5B item "La Casa" as the answer language) as well as the reverse scenario where the Spanish language is the question language and the English language is the answer language (see Stansvik FIG 5B 92, 94, 96 "La Casali as the question language and the "The House" as the answer language).

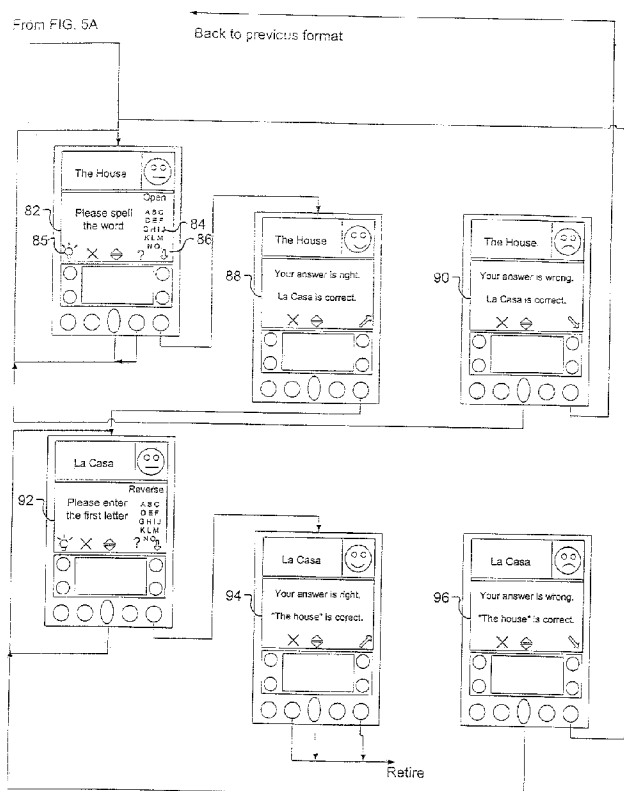Stansvik's Figure 5 is set forth below.

FIG. 5B

The evidence in FIG. 5B and in the text of Stransvik is only that a question is posed in English and then an answer is given in a foreign langue such as Spanish. Specifically, Stansvik states: "[i]n display 45, a Spanish-language quiz is shown, with the question posed, along with the appropriate answer. The question consists of an English term, while the answer consists of a Spanish term". Stansvik is silent as to mixing and matching four different variables as in Appellants' claim 1. The rest of the cited language of Stansvik is set forth below:

> [0048] FIGS. 5A and 5B illustrate, through a flow diagram, educational
> information that may be displayed to a student. In particular, various displays are
> shown of questions that may be posed to a student, along with the displays
> that result, based upon various answers by the student. The questions may
> represent various fact elements and may be displayed in a number of different
> formats. Display 45 includes a question area 46, an answer area 47, and feedback
> area 48. Any of these areas and other areas of display 45, such as control area 49,
> may also be used to input information. In addition, buttons 51 may be used for
> input and control, either alone or in combination with display 45. In display 45, a
> Spanish-language quiz is shown, with the question posed, along with the
> appropriate answer. The question consists of an English term, while the answer

consists of a Spanish term.

[0049] A student is provided with several options in control area 49. Arrows 50,
52 allow the student to move between questions or fact elements; up arrow 50
allows the student to review the previous question, while down arrow 52 allows
the student to skip forward to the next question. If the student skips forward, the
question does not get advanced to another format. By selecting kill button 54, the
student may eliminate, or retire, a fact element from consideration, so that it is not
presented again during a testing session. Alternatively, the kill option may only be
provided after the student answers a question correctly, so that the student cannot
kill a fact element that the student has not learned. If the student would like to
advance to the next fact element and have the current fact element displayed in a
different format in the future, the student may select promote button 56, although
it is possible to only present promote button 56 if the student has answered a
question correctly.

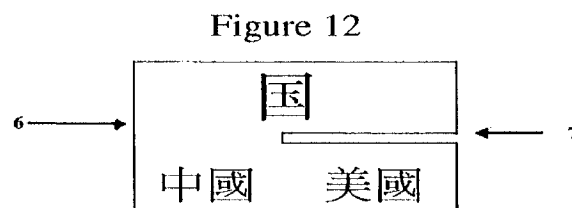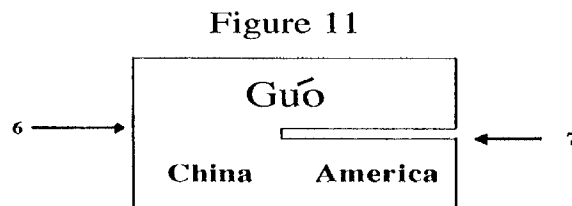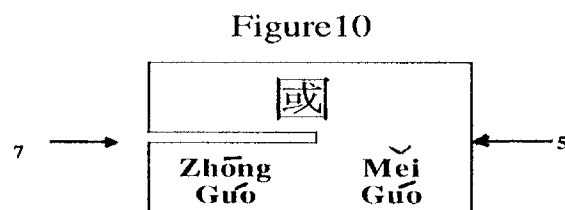Thus, Stansvik is silent as to disclosing the features of the properly construed claim 1.
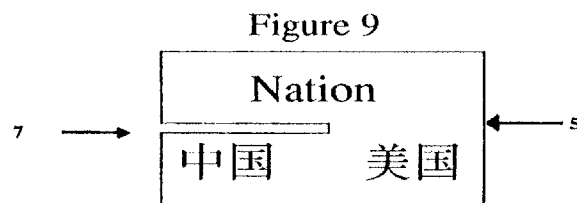
The Examiner attempts to remedy the deficiency of Stansvik by citing Loebner. The
Examiner admits that "[t]he Stansvik reference fails to teach the limitation of "the language of
the answer and question language is selected from Simplified Chinese, Traditional Chinese or
Pin Yin," but states that "the Loebner reference provides the teaching that the Simplified
Chinese, Traditional Chinese or Pin Yin are writing systems associated with the Chinese
language and have been observed in the past (see Loebner col. 1:30-35)." Appellants do not
disagree with this point, as that is one of the reasons for and problems solved by Appellants'
claim 1. The Examiner further states that "[t]he Loebner reference also identify that it would
have been necessary for a student trying to learn the Chinese language to learn all three different
type of writing system (orthodox/traditional Chinese, simplified Chinese and pin yin) since all
three different writing system are widely used in the Chinese language [see Loebner col. 1:45-
2:5]." Appellants do not disagree with this point, as that is one of the reasons for and problems
solved by Appellants' claim 1. Appellants submit that so far the Examiner has not addressed
how claim 1 operates, nor how Loebner operates.

Loebener describes his invention in his own words:

In order to overcome these difficulties, I have invented a new and useful "multi-
card" to assist in the learning or Chinese. The design or the multi-card is such that
it permits four different classes of information to be associated in a single multi-
card. As a consequence, the student can learn and test himself on the associations

between an English word, the pinyin pronunciation, the orthodox character and the simplified character. Although I invented the multi-card to assist in learning of Chinese, my invention can be used to associate any four domains or interest. For example, it could be used as a tool to help learn or review English, French, Spanish, and German languages.

Loebner is directed to a multiple card flash card that assists memorization in English and Chinese. See Loebner, Abstract. Loebner teaches a multiple card flash card wherein one language is displayed at a time. See Loebner, col. 3, ll. 25-32 (stating that three flips display words in Pin Yin, orthodox, and simplified and a fourth flip will display English). Appellants do not dispute that Loebner provides cards for viewing four classes of information, including orthodox/traditional Chinese, simplified Chinese and Pin Yin and English as disclosed in Loebner's Figure 9 (shown below).

Figure 9

Nation

中国　　美国

Figure 10

國

Zhōng　Mei
Guó　Guó

Figure 11

Guó

China　　America

Figure 12

国

中國　　美國

Next, the Examiner states that "[i]n practice, the combination of the Stansvik with Loebner will only change the type language and writing system that can be displayed in Stansvik's display device."

It is at this point, where the Examiner states "[i]n practice, the combination of the Stansvik with Loebner will only change the type language and writing system that can be displayed in Stansvik's display device" that the Examiner errs, because Stansvik does disclose a system that will function as claimed, but could only perform displaying English and one other language. Appellants submit that the Examiner errs because the Examiner does not interpret all words of the claim and construe the claim in accordance with the full limitation. The Examiner's logic is based on the premise that Stansvik discloses the basis of the claimed invention--the functionality to disclose sixteen different combinations based on two selections by a user. The Examiner's error is further demonstrated when the Examiner proceeds to combine Loebner with Stansvik, stating:

> Since the Stansvik reference already provide a teaching of providing foreign language lesson (see Stansvik paragraph 45 and 69), the combination of Stansvik and Loebner will only extend the amount of the language training that the Stansvik reference is capable of.

The Examiner has reduced claim 1 to a "gist" and refers to the claim limitation as "providing a foreign language lesson." Loebner cannot extend the capability of Stansvik because only one language at a time can be taught.

B.   **The Proposed Combination Fails to Teach or Suggest "wherein a determination if the answer is a correct answer is performed by determining whether the vocabulary word and the answer both match an entry in a Traditional Chinese/Pin Yin/English dictionary encoded in Unicode"**

The Examiner states that the "appellant argues that the combination of Stansvik, Edberg, Kobayashi and Loebner references fail to provide the teaching of "... wherein a determination if the answer is a correct answer is performed by determining whether the vocabulary word and answer word match an entry in a Traditional Chinese/Pin Yin/ English dictionary in Unicode."

The Examiner states:

> The Stansvik reference already provides a teaching a determination if the answer is a correct answer is performed by determining whether the vocabulary word and answer word match an entry in a dictionary (see paragraph 57).

Stansvik, paragraph '0057] states:

> [0057] Alternatively, the question could be a phrase that requires a phrase as an answer. In the true/false format, both the question phrase and a purported answer phrase may be displayed. In the multiple-choice format, the question phrase and several purported answer phrases may be displayed. In both the open-ended and reverse open-ended formats, one of the phrases may be presented, and the student may be asked to provide the other phrase or key words within the phrase. Under any option, the system may be provided with a thesaurus, dictionary, or other feature that will accept answers as correct even if they are not exact matches for the desired words or phrases.

Appellants submit that Stansvik only discloses that a dictionary "that will accept answers as correct even if they are not exact matches" is suggested, and that Stansvik is silent as to a "Traditional Chinese/ Pin Yin/English dictionary encoded in Unicode."

The Examiner states "[w]hile it would have been inherent that some sort of encoding system would be needed to implement the electronic dictionary, as disclosed by Stansvik, the Stansvik reference do not explicitly disclose what type encoding system used in the reference." Appellants submit that the Examiner correctly states "[a]dditionally, the Stansvik reference also fails to teach where the dictionary is a Traditional Chinese/Simplified Chinese/Pin Yin/English dictionary." To remedy this deficiency, the Examiner cites Edberg:

> The Edberg reference provides a teaching that the Unicode is the computing industry standard that allow consistent display of a language writing system (see Edberg col. 1:55-2: 10) and the Kobayashi reference shows that how to encode the Chinese writing system using Unicode encoding (see Kobayashi paragraph 91 and 46 and FIG. 3).

Appellants submit that Edberg only mentions Unicode, and is silent as to its use for any Asian language in general, and Chinese in particular. Edberg is very specific about the languages and groups of languages to which it refers. The cited portion of Edberg is set forth below:

> Code sets have developed in an effort to address part of this problem. The most popular standard sets are the ISO 8859 series. ISO 8859-1 (Latin-I) covers Western European languages; ISO 8859-2 covers Eastern European languages;

ISO 8859-3 covers Southeastern European languages; ISO 65 8859-4 covers Northern European languages; ISO 8859-5 covers English & Cyrillic-Based languages; ISO 8859-6 covers English & Arabic; ISO 8859-7 covers English & Greek; ISO 8859-8 covers English & Hebrew; ISO/IEC 8895-9 covers Western European & Turkish; and ISO/IEC 8859-10 covers Danish, English, Estonian, Faeroes, Finnish, 5 German, Greenlandic, Icelandic, Lappish, Latvian, Lithuanian, Norwegian, and Swedish. Most code sets and encoding methods each support one language or a group of related languages. However, this method will be insufficient if the need for the blend of 10 languages is more exotic. For example, the combination of French and Arabic-a common mix in Northern Africa-is a problem because one requires ISO 8859-1 (Latin-I), while the other requires ISO 8859-6. A partial solution has been an effort to combine all characters into a universal code set.

As stated above, Edberg is silent in regard to Chinese. A reference to Unicode comes in the following paragraph.

The idea of a universal set is to combine every character for all commonly used scripts and languages, as well as all the symbols one would need, in one large code set called Unicode. Unicode is explained in The Unicode Standard, World Character Encoding, Version 1.0, Volume 1, the 20 Unicode Consortium, Addison-Wesley Publishing Company, Inc., 1990. For further background information regarding internationalizational issues in programming, see Sandra Martin O'Donnell, Programming for the World, A Guide to Internationalization, PTR Prentice Hall, 1994.

Appellants acknowledge that Unicode is in the prior art, as they did in their application. But the evidence does not indicate a disclosure of the claim limitation, nor any motivation to combine references to create such a dictionary.

Kobayashi paragraph 91 and 46 and FIG. 3 does not remove the error. The Examiner says little about Kobayashi. Indeed, Kobayshi is silent as to Unicode. A word search of Kobayashi reveals zero results in the entire specification and claims. Kobayashi acknowledges that oriental languages use characters, and that is about all that can be said for Koybayashi.

In order to combine the cited art, the Examiner states the following:

In short, the examiner argues that each of the reference in the combination will describe to one of ordinary skilled in the art where the modification should be implemented, what information should be included in the system modification and how those new information should be encoded in the Stansvik system. In this

particular case, the base Stansvik reference provide a teaching of an electronic dictionary ready for improvement by adding an additional world language. The Loebner reference provides a teaching of what kind of information that can be added in the electronic dictionary of Stansvik, namely, the addition Chinese language with its unique writing system. Lastly, the Edberg and Kobayashi reference provide a teaching how the Chinese writing system can be encoded in an electronic/computer dictionary.

Appellants submit that the Examiner erred because he misconstrued the claimed invention by ignoring all words in the claim when comparing the prior art, and in combining the references because the references do not have the requisite teaching to support a motivation to combine. As explained above, Edberg does not link Unicode to the Chinese language and Kobayahi does not mention Unicode at all. Therefore, the Examiner's basis for combining the references is error.

Even if the Examiner were to argue that the limitations were inherent in the combination of the cited art, such argument would be error. The limitations are not explicitly disclosed, and cannot be shown to necessarily follow from the cited art. The fact that a certain result or characteristic _may_ occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

C.   The proposed combination of Stansvik in view of Loebner cannot be made because the proposed combination renders the cited reference inoperable for its intended purpose

In response to the Appellants' argument that the combined references would produce an inoperative device, the Examiner states:

> The appellant argues that the to make proposed combination one of ordinary skilled in the art would have to replace Stansvik's question and answer sequence with Loebner's teaching of displaying one language at a time. The appellant also argue that the user would no longer be required to answer the Stansvik question. The examiner respectfully disagrees. Firstly, the examiner never suggested that such modification be done. Secondly, the only modification suggested by the examiner is to add the language that would be available in the Stansvik system. As explained earlier the Stansvik reference already provide a teaching of a system that is able to ask vocabulary question in one language and enable to student to answer in another language (i.e.: Spanish-English question-answer system and English-Spanish question-answer system). The modification that one of ordinary skilled in the art would be required to do would be concentrated on the display system in order to enable the system to display different Chinese character writing system and the addition of Chinese character information in Stansvik electronic dictionary. The modification to add other language lesson other than Spanish language lesson can be found in the Stansvik reference (see paragraph 69). Moreover, the Stansvik reference also teaches that the scoring and performance tracking system can also be used in monitoring various learning module and language learning module (see paragraph 71-72). Since, the modification to add another world language has already been expected by the Stansvik reference and the fact that the Stansvik scoring and performance tracking system can be used to track vocabulary progress of a language; the examiner argues that the combination of Stansvik and Loebner reference would not cause the Stansvik reference to be inoperable.

Indeed, Examiner states: "[s]econdly, the only modification suggested by the examiner is to add the language that would be available in the Stansvik system" and "[a]s explained earlier the Stansvik reference already provide a teaching of a system that is able to ask vocabulary question in one language and enable to student to answer in another language (i.e.: Spanish-English question-answer system and English-Spanish question-answer system)." Applicants submit that the Examiner's statement is proof of the error because the Examiner acknowledges that only a two language combination is available at any one time, but a selection of sixteen different combinations cannot be made. Therefore, a student could not interact on a lesson with the sixteen combinations set forth in the claim limitation.

II.   GROUND OF REJECTION 2 (Claims 5, 6, 18 and 19 – Group B)

Claims 5, 6, 18, and 19 stand rejected under 35 U.S.C. § 103(a) over Stansvik, in view of Edberg, in view of Kobayashi, in view Loebner, and further in view of Resor. Claim 5 is representative of group B (claims 5, 6, 18 and 19) with respect to ground of rejection 2, and the same arguments made for Claim 5 apply to claims 6, 15 and 19.

A.   The Proposed Combination Fails to Teach or Suggest "calculating the probability factors for the plurality of vocabulary words"

The Examiner states that "[t]he appellant argues that the Roser reference fails to provide a teaching of "... calculating a probability factor for the plurality of vocabulary words and wherein the probability factors determines a probability that the vocabulary will appear in a question," "[t]he appellant argues that the Resor reference fails to teach the teaching of vocabulary word," and the "appellant also argues that the Resor reference is only directed toward arithmetic teaching and not vocabulary/language teaching."

The Examiner disagrees stating:

> The examiner would like to note that both the Resor and Stansvik reference are references that present question to be displayed to the student. The Stansvik reference is silent on exact algorithm on how a particular is selected and displayed to the student. The Resor reference provides a teaching of selecting a question based on the relative probability that is associated to each problem (see Resor paragraph 354). The examiner also notes that the MPEP specifically allows the use of similar or known technique to improve similar devices (see MPEP 2143). Since, both the Resor and Stansvik reference are similar devices (i.e.: electronic device that select and present question to the user) the examiner takes the position that the inclusion of the Resor algorithm to the Stansvik device would the modification will provide an improvement in the base reference. In this particular case, the Resor reference teaches a prior art of method of selecting a particular question using a known technique, namely, the technique of using a probability factor to select which question to be displayed to the user. Thus, it would have been recognized by one of ordinary skill in the art that applying the known technique taught by Resor to the education system of Stansvik would have yielded predicable results and resulted in an improved system, namely, a system that would select a question that is appropriate to the capability of the student (see Resor paragraph 355 and 356). One of ordinary skilled in the art would have been motivated to make the Stansvik and Resor combination since the Resor reference teaches that the probability based selection system is more efficient and less time consuming in selecting the appropriate problem for the user (see paragraph 356).

The Examiner does not dispute that Resor is silent as to vocabulary addressed to teaching arithmetic. Calculating a probability for a plurality of vocabulary words is a specific type of calculation, and is not disclosed in Resor, either explicitly or inherently. Furthermore, the Examiner did not construe the term "probability factors." The full claim limitation states "wherein the probability factor determines a probability that the vocabulary word will appear in a question." Such a calculation is not disclosed in the cited art, and cannot be shown to be inherent, because such a calculation does not necessarily follow from a combination of the cited art. Such a calculation cannot follow from the combination because there is no mention of vocabulary words in the cited art.

B.   The Examiner Failed to State a Proper Reason to Combine the References to Achieve the Legal Conclusion of Obviousness

The appellant also argues that the combination of Stansvik, Edberg, Kobayashi, Loebner and Roser is not valid since the examiner has not shown legal motivation to combine. The examiner respectfully disagrees. The examiner's motivation of combining the Resor reference with the Stansvik reference is taken explicitly from the Resor reference, namely, to increase the efficiency of the problem selection algorithm (see Resor paragraph 356). The examiner also notes that the type of modification suggested the use of similar of known technique to improve similar devices, in the rejection and this appeal brief has been identified to be a proper rationale to support an obviousness type rejection [See MPEP 2143 - Exemplary Rationale (Cl].

As shown above, the Examiner has reduced claim1 to a "gist" and refers to the claim limitation as "providing a foreign language lesson. Loebner cannot extend the capability of Stansvik because only one language at a time can be taught.

III.   GROUND OF REJECTION 5 (Claims 10 and 23 – Group D)

Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) over Stansvik, in view of Edberg, in view of Kobayashi, in view Loebner, in view of Resor, and further in view of Frank. Office Action dated January 26, 2009 pp. 6-7. Claim 10 is representative of group D (claims 10 and 23) with respect to ground of rejection four, and the same arguments made for Claim 10 apply to claim 23.

A.   **The Proposed Combination Fails to Teach or Suggest "wherein responsive to a determination that all of the vocabulary words in a chapter have a probability factor equal to one, indicating that the chapter is completed"**

The Examiner responds stating "[a]s explained in the rejection above, examiner finding of obviousness is based upon the examiner's determination that what the appellant refer as "probability factor" and "probability factor equal to one" are analogous to the term "score" and "cut-off score" in the Frank reference." Specifically, the Examiner states:

> The examiner points to the appellant's specification that explains on the probability factor is calculated (see appellant's specification page 11 line 20 - page 12 line 5). The appellant's specification taught that the probability factors are increased or decreased based on the student's correct and incorrect answer question. Similarly, a score is increased or decreased when a student submit a correct or incorrect answer to a question. The appellant's specification also taught that when probability factor is equal to one to all the system will stop presenting additional question (see IFG 4 item 328 and page 13 line 15-23). Similarly, the Frank reference also taught of a "cutoff" score that when reached will stop the system from asking will stop presenting additional question (see Frank FIG 4B item 518 col. 7:55-65 and col. 14:40-55). Since, the term "probability factor" in the claim behaves in a similar manner with the "score" term in the Frank reference, the examiner consider these two terms to be analogous and identical to each other. As such, the examiner concludes that the "probability factor equal to one" to be analogous to the cutoff score that is used and suggested by the Frank reference.

Appellants submit that the Examiner admits that the claim limitation is not present in the cited art. The fact is that "probability factor" and "probability factor equal to one" are not the same as "score" and "cut-off score." Therefore, the Examiner must "analogize." However, the terms cannot work in the same way because the claim explicitly states "indicating that the chapter is completed." Every word in the claim limitation must be considered.

B.   **Frank is Non-Analogous Art**

In response to Appellants' argument that the combination of Stansvik, Edberg, Kobayashi, Loebner, Roser, Boon, and Frank is not valid since the Frank reference constitutes a non-analogous art, the Examiner states:

> The appellant argues that the Frank reference is not from the same field of endeavor from the claimed invention and the teaching of Frank is not particularly

pertinent to the problem as specified by the appellant. The examiner respectfully disagrees. Firstly, both the appellant's and Frank reference resides in the same general area of electronic/computer testing. Both the appellant's claimed invention present question to the user and receives answer to the question from the user. The appellant also argues that the field of employee retention and Chinese/English vocabulary are completely distinct from each other. The examiner respectfully disagrees. Since, one can certainly point to at least one type of employment that may require an employee to possess Chinese/English communication skill (e.g.: a translator). In such particular case, the field of employee retention and vocabulary are certainly very related. Lastly, the examiner would like to point out that the teaching of the Frank reference is not used as an employee retention system in the rejection. The examiner has shown that the Frank reference is only used to as a teaching on how the score and cut score can be processed in an electronic learning system. As such, the examiner argues that the field of endeavor in this particular case is not the vocabulary testing suggested by the applicant; rather; the field of endeavor is the electronic testing and scoring. As such, the examiner takes the position that the Frank reference and appellant's claimed invention to be analogous art.

Appellants submit the Examiner is at best making an inherency argument. The Examiner states "[s]ince, one can certainly point to at least one type of employment that may require an employee to possess Chinese/English communication skill (e.g.: a translator). In such particular case, the field of employee retention and vocabulary are certainly very related." The use of the word "may" admits of an inherency argument. The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

CONCLUSION

The Examiner erred by not interpreting all words of the claim and construes the claim in accordance with the full limitation as described by all of the words together. Furthermore, the Examiner erred by combining references without, again, addressing all words of the claim limitations. Additionally, the Examiner erred by citing art that did not disclose all of the limitations for which it was cited. The Examiner should be reversed.

Date: September 4, 2009   /Rudolf O. Siegesmund/

                                                          Rudolf O. Siegesmund
                                                          Reg. No. 37,720
                                                          Yee & Associates, P.C.
                                                          P.O. Box 802333
                                                          Dallas, TX 75380
                                                          (972) 385-8777
                                                          Attorney for Applicants